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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HOFFMAN WARNICK & D'ALESSANDRO, LLC			STERRETT, JONATHAN G	
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ALBANY, NY 12207			PAPER NUMBER	
			3623	
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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/849,291	<b>Applicant(s)</b> FRIEDLANDER ET AL.	
	<b>Examiner</b> Jonathan G. Sterrett	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5-4-2001</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Summary*

1. Claims 1-33 are pending in the application. The instant application deals with a system and method for evaluating the capabilities of an organization. More specifically, the invention deals with providing the ability to assess how well an organization can implement a change throughout a hierarchy in the organization and in recommending actions to improve this capability. The application of a method and system to assess the capability provides the means to process and quantify responses to various query topics in order to quantify the capability and compare it to a predetermined value that represents a standard. Determining the difference between a quantified response and a numerical standard allows for determination of a corrective action to remedy the organizational deficiency.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-14 and 23-31** are rejected under 35 U.S.C. 101 because the invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts: and
- (2) whether the invention produces a useful, concrete and tangible result.

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4. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, none of **Claims 1-14 and 23-31** are directed to anything in the technological arts as explained above. Specifically for **Claim 1**, the limitation “querying a hierarchy in an organization” is cited. This limitation can be performed manually without utilizing technological elements. Further in Claim 1, the limitation “quantifying a baseline response into a raw score” is cited. In Claim 1, the limitation of “comparing the skill score with a required score” is cited. These limitations can be performed manually without utilizing technological elements. Specifically for **Claim 23**, the limitations of ‘a comparison system’ and an ‘output system’ are cited. While a system is cited, nothing else in the claim recites system elements that describe computer-related components. Typically, a system is composed of hardware elements including at least memory and a processor. The limitations following the simple limitation of ‘system’ can be performed manually. Looking at the claims as a whole, nothing in the body of the claims recites any structure or functionality to suggest that a computer or any technology performs the recited steps. Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful,

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concrete, and tangible result. In the present case, the claimed invention provides a method and system for implementing technical change through assessing an organization, which is a useful, concrete and tangible result. Although the recited process produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, **Claims 1-14 and 23-31** are deemed to be directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 15-22** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **Claim 15**, the preamble of the claim describes a software product while the body of the claim describes system elements. A system is composed of both software and hardware elements. The claim is indefinite because it is not clear how a software product can be comprised of system elements.

**Claims 16-22** are dependent upon **Claim 15** and are therefore indefinite accordingly.

***Claim Rejections - 35 USC § 102***

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7. The following is a quotation of the appropriate paragraphs of 35 U.S.C.

102 that form the basis for the rejections under this section made in this Office

action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1, 3-6, 11-13, 15, 17-20, 21, 23, 25, 26 and 28-30** are rejected

under 35 U.S.C. 102(e) as being anticipated by **Guinta US 6,161,101**.

Regarding **Claim 1**, Guinta discloses:

**querying a hierarchy in the organization to obtain a baseline response;**

Column 3 line 61-65, assessor determines who in the organization should be queried in order to provide an organizational assessment. This would include identifying a hierarchy (i.e. chain of command) in the organization whose input would be entered into the system. E.g. column 4 line 34-36 – individuals in the hierarchy identified to provide assessment input.

Column 5 line 11-13, questions are posed to obtain an input into the system (i.e.. baseline response).

**quantifying the baseline response into a raw score;**

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column 7 line 45-47, the input (i.e. baseline response) can be filtered using a variety of mathematical operations to be quantified (i.e. quantified into a raw score).

**modifying the raw score to yield a skill score; and**

column 9 line 44-47, scores can be modified based on a wide variety of factors

**comparing the skill score to a predetermined required score to determine a predicted response to the technical change.**

Column 11 line 45-46, the resulting scores (i.e. skill scores) are compared to selected thresholds (i.e. predetermined required score) to determine specific problem areas. If the resulting scores are lower than the threshold scores, then the system predicts there is a deficiency in the response in that particular area.

Regarding **Claim 3**, Quinta discloses:

**querying a hierarchy in the organization;**

Column 3 line 61-65, assessor determines who in the organization should be queried in order to provide an organizational assessment. This would include identifying a hierarchy (i.e. chain of command) in the organization whose input would be entered into the system. E.g. column 4 line 34-36 – individuals in the hierarchy identified to provide assessment input.

Column 5 line 11-13, questions are posed to obtain an input into the system (i.e.. baseline response).

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**and receiving a set of hierarchy responses to the querying to yield the baseline response.**

Column 4 line 39-41, any number of different individuals from different departments, including hierarchies in that department, may be select to enter inputs into the system. The total group of responses from these individuals would comprise a set of responses.

Column 7 line 52-54, e.g. a set of 100 different issues were assessed (i.e. responses received into system) from 10 assessors.

Column 5 line 11-13, questions are posed to obtain an input into the system (i.e.. baseline response). Any number of individuals in a hierarchy can provide input into the baseline response.

Regarding **Claim 4**, Guinta discloses:

**the step of providing queries organized into query topics for querying the hierarchy.**

Column 13 Table 1, this table illustrates an example of how the system disclosed by Guinta has queries organized into topics for querying the hierarchy. For example, 4.1 is the topic of 'Management Responsibility' and 4.2 is a set of queries addressing the 'Quality System'.

Regarding **Claim 5**, Guinta discloses:

**wherein the query topics comprise:**

**leadership,**



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Column 13 table 4.1 "Management Responsibility" deals with leadership responsibilities within the management function in queries 1-7.

**planning,**

column 13 table 4.1 "Management Responsibility" deals with planning in queries 8.1-8.4.

**administration,**

column 18 table 4.16 'Control of Quality Records' deals with the overall administration of quality recordkeeping.

**operations,**

Column 20 table II.3 –"Manufacturing Capabilities" is an operations category.

**quality assurance,**

Column 19 table 4.17 –"Internal Quality Audits" deal with quality assurance.

**communications,**

Column 19 table 4.19 –'Servicing' ensures that data is communicated to supplier, manufacturing, engineering and design activities

**project management, and**

column 14 table 4.4 "Design Control" deals with project management within the design context, e.g. query 1 "Design plans for each project have been established and responsibility assigned".

**training.**

Column 19 table 4.18 – "Training"

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Regarding **Claim 6**, Guinta discloses:

**wherein each query comprises a set of questions.**

Column 5 line 1-2, a series of questions are posed as part of a single query.

**Claims 11-13, 15, 20, 21, 23, 25 and 28-30** recite similar limitations as those recited in **Claims 1 and 3-6** above, and are therefore rejected under the same rationale.

Regarding **Claim 17**, Guinta discloses:

**wherein the quantification system converts the inputted responses into values to yield the raw score.**

Column 5 line 42-46, a user can input on a sliding scale on the computer their perception of how well the organization performs on an issue. The sliding scale is used by the computer program to convert the inputted response into a value for the inputted value – see Figure 7 and column 10 line 44-47

Regarding **Claim 18**, Guinta discloses:

**wherein the modification system performs a mathematical operation on the raw score with a modifier to yield the skill score.**

Column 9 line 44-46, the numerical input (i.e. raw score) can be modified using a wide variety of factors to correlate the response with an output desired.

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This would include using a mathematical operation to revise (i.e. modify) the numerical input so that the result is correlated with the input information.

Regarding **Claim 19**, Guinta discloses:

**wherein the comparison system determines the mathematical difference between the skill score and the predetermined required score to yield the predicted response.**

Column 11 line 40-46. The inputted response is converted into a numerical value. A predetermined threshold value is compared with the numerical value to determine if the threshold value is exceeded. The only way to determine if the threshold value is exceeded is to determine the mathematical difference between the numerical value (i.e. skill score) and the threshold value (i.e. predetermined required score). If the threshold values are not exceeded, resulting in a negative difference (i.e. predicted response), this means that the organization would have a weakness requiring corrective action – see column 11 line 47-50 and column 11 line 56-58

**Claim 26** recites similar limitations as those recited in **Claim 19** above, and is therefore rejected under the same rationale.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 2, 7-10, 14, 16, 22, 24, 27 and 31-33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Guinta in view of Curtis.

Curtis, Bill; Hefley, William E.; Miller, Sally; "People Capability Maturity Model<sup>SM</sup>", Sept 1995, Software Engineering Institute, CMU/SEI-95-MM-02, sections O, L1-L4.

Regarding **Claim 2**, Guinta all the limitations of Claim 1 above, and also teaches:

**recommending a corrective action based on the predicted response,**

Column 12 line 25-26, the system provides a report recommending corrective actions based on the previous assessment of the weaknesses of the organization.

Guinta does not teach:

**and implementing the technical change**

Curtis teaches:

**and implementing the technical change**

Page 041 paragraph 2 line 1-3, an action team is formed to implement the solution to remedy weakness(s) identified by the maturity model assessment.

Guinta and Curtis both address identifying deficiencies and opportunities for improvement within organizations, thus both Guinta and Curtis are analogous art.

Curtis teaches that applying CMM principles to an improvement program that implements technical changes recommended by a diagnostic or assessment program results in an organization having reduced turnover and a greater readiness to perform in fast-paced environments (page O-40 paragraph 1 line 1-2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Guinta, regarding providing organizational assessments and recommended corrective actions, to include implementing the recommended corrective actions, as taught by Curtis, because it would result in an organization having reduced turnover and a greater readiness to perform in fast-paced environments.

Regarding **Claim 7**, Guinta teaches that large entities such as corporations, professional associations and governmental units conduct assessments within their organizations, i.e. hierarchies (column 1 line 19-21).

Guinta does not teach:

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**wherein the hierarchies comprise senior management, mid-level management, administrators, analysts, operations, project management, and end users.**

The examiner takes Official Notice that it is old and well known in the art of management for large organizations such as corporations, associations and governmental units to contain hierarchies comprised of:

**Senior management** -most firms contain a hierarchy at the top comprising a chairman or CEO then on down to VP or Senior VP and on down to director level positions. Most corporate firms distinguish the senior management hierarchy by determining incentive compensation of company stock, i.e., if you receive or are eligible to receive IC, then an individual is considered senior management

**Mid-level management** – usually characterized by the director and manager and first line supervisory positions. These positions are differentiated from senior management positions in that they do not receive stock or IC options.

**Administrators** – characterized by those who are either in charge of administering and/or supervising support positions such as office staffing, secretarial or office assistant pools.

**Analysts** – characterized by a business where analyzing and responding to information is primary to the business. Good examples of organizations containing hierarchies of analysts include financial firms and government intelligence groups dealing with national security issues.

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**Operations** – characterized by those organizations involved in manufacturing or supply chain management where large numbers of individuals are organized into hierarchies due to specialization of labor.

**Project management** – characterized by organizations where conducting projects is a primary goal. Best examples here exist in construction, firms focusing on product development or defense-related government procurement (e.g. weapons systems).

**End users** –characterized by organizations where products are distributed down a hierarchy of distribution channels. A good example of this is a supply chain where a small component supplied by an organization is assembled into a progressively larger product and where each group forms a hierarchy. For example, Tier 1, 2 and 3 automotive suppliers form a hierarchy of end users.

These various hierarchies represent a broad spectrum of functional areas that are old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Guinta regarding providing organizational assessments, to include the hierarchies of senior management, midlevel management, administrators, analysts, operations, project management and end users, because it would ensure a complete and accurate organizational assessment.

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Regarding **Claim 8**, Guinta teaches all the limitations of Claim 1 above, but does not teach:

**wherein the querying step comprises the step of querying each of the hierarchies in the organization, and wherein a separate baseline response is obtained for each hierarchy and for the organization.**

Curtis teaches:

**wherein the querying step comprises the step of querying each of the hierarchies in the organization, and wherein a separate baseline response is obtained for each hierarchy and for the organization**

Page O-34 paragraph 2 line 4-6, a capability maturity assessment is a query of the hierarchies in an organization. It focuses on how hierarchies within an organization are performing with respect to each of the People-CMM practice areas. In other words, a baseline for each organization hierarchy is established.

Page O-34 paragraph 4 line 3-4, the maturity level, or baseline, for an overall organization, is the lowest level of maturity that has been achieved by any of the hierarchies in the organization.

Guinta and Curtis both address identifying deficiencies and opportunities for improvement within organizations, thus both Guinta and Curtis are analogous art.



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Curtis teaches that applying CMM principles to an improvement program that implements technical changes recommended by a diagnostic or assessment program results in an organization having reduced turnover and a greater readiness to perform in fast-paced environments (page O-40 paragraph 1 line 1-2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Guinta, regarding providing organizational assessments and recommended corrective actions, to include evaluating baseline assessments for hierarchies within the organization and for the overall organization, as taught by Curtis, because it would result in an organization having reduced turnover and a greater readiness to perform in fast-paced environments.

Regarding **Claim 9**, Guinta and Curtis teach all the limitations of Claim 8 above.

Guinta also teaches:

**wherein each separate baseline response is quantified, modified and compared to a predetermined required score.**

Column 7 line 45-47, the input (i.e. baseline response) can be filtered using a variety of mathematical operations to be quantified (i.e. quantified into a raw score).

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Column 9 line 44-47, scores can be modified based on a wide variety of factors

Column 11 line 45-46, the resulting scores (i.e. skill scores) are compared to selected thresholds (i.e. predetermined required score) to determine specific problem areas. If the resulting scores are lower than the threshold scores, then the system predicts there is a deficiency in the response in that particular area.

**Claims 10, 14, 16, 22, 24, 27 and 31-33** recite similar limitations as those recited in **Claims 2 and 7-9** above, and are therefore rejected under the same rationale.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 2003/0018487 by Young discloses a system for assessing and improving the social responsibility of a business.

US 2002/0123943 by Gupta discloses a method and system for measuring product shipment capability.

US 2002/0007348 by Ali discloses a system and method for performing engineering design. This invention utilizes QFD to gather and quantify responses and input from customers.

US 2003/0009346 by Shimizu discloses a method for providing individual assessment and identifying growth opportunities for the purpose of developing the organization where they reside.

US 6,321,205 by Eder discloses a method and system for modeling and analyzing business improvement programs

US 6,286,005 by Cannon discloses a method and system for analyzing data and advertising optimization.

US 5,724,262 by Ghahramani discloses a method for measuring the usability of a system for task analysis and reengineering. This method provides for survey collection and analysis to provide for system changes to improve the system.

US 6,341,267 by Taub discloses a method and system for assessing performance of individuals and providing a comparison of the assessment to further improvement.

Burnstein, Irene; Homyen, Ariya; Grom, Robert; Carlson, C.R.; "A Model to Assess Testing Process Maturity", November 1998, Illinois Institute of Technology, pp.1-9. [www.stsc.hill.af.mil/crosstalk/1998/11/burnstein.asp](http://www.stsc.hill.af.mil/crosstalk/1998/11/burnstein.asp).

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Low, Jonathan, "The Value Creation Index", 2000, Journal of Intellectual Capital, v1n3, pp.252-262, Dialog 02230040 82396297.

Taormina, Robert J; Bauer, Talya N; "Organizational socialization in two cultures: Results from the United States and Hong Kong", 2000, International Journal of Organizational Analysis, v8n3, pp.262-289, Dialog 02109006 66810374.

Barnett, William D; Raja, M K; "Application of QFD to the software development process", 1995, International Journal of Quality and Reliability Management, v12n6, pp.24-42, Dialog 01074295 97-23689.

Van Wart, Montgomery, "The First Step in the Reinvention Process: Assessment", Sept/Oct 1995, Public Administration Review, v55n5, pp.429-438. Dialog 01091481 97-40875.

Monczka, Robert M.; Trent, Robert J.; "Worldwide Sourcing: Assessment and Execution", Fall 1992, International Journal of Purchasing and Materials Management, v28n4, pp.9-19, Dialog 0064920 92-64180.

Rubin, Howard, "Measure for Measure", April 1991, Computer World, v25n15, pp.77-78, Dialog 00546777 91-21122.

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Sturman, Michael C.; "Implications of Utility Analysis Adjustments for Estimates of Human Resource Intervention Value", March-April 2000, Journal of Management, v26, n2, p281, Dialog 10041272 63129118.

**Conclusion**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G. Sterrett whose telephone number is 703-305-0550. The examiner can normally be reached on 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGS

JGS 5-30-2005

*Romain Jeanty*  
Primary Examiner  
Art Unit 3623  
6-8-2005